

REMARKS

This amendment is submitted in response to the outstanding Official Action mailed November 16, 2006. In view of the above claim amendments and the following remarks, reconsideration by the Examiner and allowance of this application is respectfully requested.

Claim 75 – 78, 80, 82, 84, 88 – 91, 93, 95, 99 – 102, 104, 106 and 108 have been amended to more particularly point out and distinctly claim the subject matter that Applicant regards as the invention. In particular, Claim 75 has been amended to replace the suggestive limitations with positively recited method steps that are required to be performed, so that Claim 75 is now directed to *creating* a third party account linked to a fund depositor's bank or credit card account using information entered by the fund depositor with a personal computer, *programming* with a personal computer a periodic and automatic transfer of funds into the third party account from the fund depositor account, *encoding* a magnetic card with third party account information permitting cash withdrawals or fund transfers as payments for goods and services, and *issuing* the magnetic card to the son or daughter of the fund depositor. No new limitations have been added. This is a re-writing of Claim 75 that does not introduce new matter. Claims 88 and 99 have been similarly re-written without adding new matter to incorporate two or more of the foregoing limitations.

Claims 75, 82, 84, 95, 99, 106 and 108 have been amended to clarify that the information being supplied refers to the information previously stored. This refers more precisely to the language of a previous claim to address rejections for lack of antecedent basis and does not introduce new matter.

Claims 76, 89 and 100 have been amended to recite more positively that the fund depositor account and said third party account communicate through an external bank, credit card or atm network. This is also a re-writing of the claims without adding limitations, which does not introduce new matter. Claims 77, 90 and 101 have been simplified to recite more positively that the fund depositor account is a new account. This is another re-writing of the claims without adding limitations that does not introduce new matter.

Claims 78, 80, 91, 93, 102 and 104 have been amended to clarify that “each transfer” is “a fund transfer.” This also does not introduce new matter. Finally, claims 80, 93 and 104 have been amended to clarify that the command instructions from said fund depositor are entered by the fund depositor on a personal computer. Support for this limitation has been previously identified and does not introduce new matter.

Instead, the claim amendments resolve the Examiner’s objections regarding suggestive or optional method steps and indefinite claim language. Reconsideration of these and the prior art rejections in view of the following remarks is therefore respectfully requested.

Turning to the Official Action, the Examiner objected to the claims as reciting suggestive or optional method step, citing M.P.E.P. §2106 and noting that such language could not be read as limiting the claims. This rejection is respectfully traversed in view of the above claim amendments for the reasons set forth hereinafter.

As noted above, independent claims 75, 88 and 99 have been amended to recite positive method step that are required to be performed. By amending the independent claim in this manner the Examiner’s objection has thus been overcome. Reconsideration by the Examiner and withdrawal of this objection is therefore respectfully requested.

Next, Claims 75 – 85, 87 – 96, 98 – 108 and 110 were rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter Applicant regards as the invention. Claim 75, 84, 99, 106 and 108 were rejected because it was not clear whether the displayed information referred to the information that was used to establish the account or the transaction information that was stored. Claims 75, 88 and 99 were rejected because “the periodic and automatic transfer” lacked antecedent basis. Claims 78, 80, 88 and 99 were rejected because “each transfer requested” and “the request” lacked antecedent basis. The remaining claims were rejected for depending from a rejected claim. This rejection is respectfully traversed in view of the above claim amendments for the reasons set forth hereinafter.

Claims 75, 84, 99, 106 and 108 have been amended to clarify that “said information” is the stored information. Claims 75, 88 and 99 have been amended to replace “the periodic and automatic transfer” with “a periodic and automatic transfer.” “The request” has been deleted from claims 88 and 99 to render this rejection moot. Finally, Claim 78 and 80 have been amended to clarify that “each transfer requested” is “is a cash withdrawal or fund transfer request” (Claim 78) or “a fund transfer request” (Claim 80).

By amending Claims 75, 78, 80, 84, 88, 99, 106 and 108 in this manner, the lack of antecedent basis in each claim identified by the Examiner has been corrected, so that the rejection of Claims 75 – 85, 87 – 96, 98 – 108 and 110 under 35 U.S.C. § 112, second paragraph as being indefinite has thus been overcome. Reconsideration by the Examiner and withdrawal of this rejection is therefore respectfully requested.

Finally, Claims 75, 78, 80, 84, 88, 99, 106 and 108 were rejected under 35 U.S.C. § 103(a) as being obvious in view of the combined teachings of Nakano et al., U.S. Patent No. 5,845,260 in view of Anderson et al., U.S. Patent No. 5,706,442. Nakano et al. was cited as disclosing using information entered by a depositor with a PC to create a third party account linked to a depositor account, periodically and automatically transferring funds from the depositor account into the third party account, limiting the funds spent and how the fund are spent, and viewing information on how the funds were spent.

The Examiner acknowledged that Nakano et al. did not disclose supplying the depositor through a CRT or LCD output device information stored on fund transferees and corresponding payment amounts for the third party account but cited Anderson et al. as disclosing this. This rejection is respectfully traversed for the reasons set forth hereinafter.

The following is a summary of disclosure relevant to the subject matter of the independent claims that was presented in the priority application filed April 16, 1996:

1. The system is supported by a major credit card company.
2. John Doe has a credit card with that company and wants to give his son and daughter a monthly allowance.

3. He has the credit card company issue two magnetic allowance cards linked to his account for use by his son and daughter.
4. He instructs the credit card company to charge \$80 to his account every month and put \$40 on each child's allowance card.
5. If the child chooses to spend the money quickly or slowly, it is their choice, however they will not get any more money until the next month.
6. The day, place, amount and items that were purchased by the child are documented.
7. There is control over monies deposited for certain purchases by dependents, and the purchase of alcohol or tobacco can be prohibited.

Applicant submits that the Application filed April 16, 1996 thus provides enabling and therefore priority support for (A) creating a third party account with a bank linked to a bank or credit card account of a fund depositor; (B) programming a periodic and automatic transfer of funds into the third party account from the fund depositor account; (C) encoding a magnetic card with third party account information permitting cash withdrawals or fund transfers as payments for goods or services; (D) issuing the magnetic card to a son or daughter of the fund depositor; (E) storing information on fund transferees and corresponding payment amounts. Furthermore, Applicant has already supplied a Rule 131 Declaration documenting conception of the invention described in the Application filed April 16, 1996 on a date prior to September 25, 1995 followed by the diligent constructive reduction to practice of the invention from the December 20, 1995 filing date of Anderson et al. to a date no later than April 16, 1996.¹ This predates the filing dates of the Nakano et al. and Anderson et al. patents to the extent these patents disclose the above-listed inventive features.

¹Applicant will demonstrate that the presently claimed invention is patentable over Nakano et al. independent of the feature disclosed by Anderson et al., in which case Applicant does not need to demonstrate invention before and diligence after the Anderson et al. filing date. Under such circumstances, diligence from the effective date of Nakano et al. must be demonstrated. Nakano et al. was filed on January 24, 1996 claiming priority from an application filed in Japan on February 6, 1995. Under the Hilmer doctrine, Nakano et al. cannot obtain the benefit of an earlier filing date in Japan. This date can serve, however, as evidence of invention in a WTO country prior to the Nakano et al. U.S. filing date. However, the effective date of Nakano et al. based on inventive activity in Japan can be no earlier than the January 1, 1996 effective date of this provision of the GATT treaty. Thus applicant need only demonstrate conception before and diligence after January 1, 1996, which was three business days before he mailed his original application to the U.S. Patent and Trademark Office.

As far as creating a third party account with a bank linked to a bank or credit card account of a depositor using information entered by the depositor with a personal computer, this is not disclosed by Nakano et al. The server/processor cited by the Examiner in FIGS. 2 and 6 of Nakano et al. is disclosed at column 3, lines 1 – 4 in the specification of Nakano et al. as being located at the cable company or content provider. At column 3, lines 60 – 62 the specification discloses that the server/processor communicates with the credit card company “via a telephone line, network or cable.” At column 6, lines 14 – 22, the specification discloses that account information provided by the parent is inputted in the server/processor at the cable company or content provider but there is no disclosure regarding how this information is supplied by the parent. One can infer that this occurs by the same means service in general is contracted with the cable company or content provider, i.e., by telephone or in-person.

The only communication disclosed between home and the server/processor by the patent specification originates with the cable box and not a PC (see column 3, line 35 – 43 of the specification). At column 1, lines 54 – 59, the specification describes the server/processor being in communication with home terminals. However, the server/processor provides content to these terminals, which is consistent with these terminals being cable boxes. At column 4, lines 1 – 4, the specification discloses that information in response to requests for transaction information are mailed to the depositor’s address.

Regardless, as noted in the previously submitted response, the claim limitations that require a personal computer be used by the fund depositor to supply the information used to create the account for his or her son or daughter and to transfer funds to the account, either by outright transfer (Claim 99) or by supplying the information needed to establish periodic and automatic allowance payments (Claims 75 and 88), are not essential to patentability but provide additional patentability over the prior art of record. For other reasons already of record, as well as those discussed above, the presently claimed invention patentably defines over Nakano et al. alone or taken in view of Anderson et al. The claimed combinations of

the seven above-listed features have already been demonstrated to patentably define over all the other prior art of record (i.e., disclosures with effective dates prior to September 25, 1995), are supported by the priority document, define over Nakano et al. for the reasons given above, and pre-date both Nakano et al. and Anderson et al.

That is, because Nakano et al. does not describe a method in which a third party account is created using information entered by a depositor with a personal computer, and this is not taught or suggested by Anderson et al, and because Nakano et al. is not otherwise prior art against the present application, Claims 75, 88, 99 and the claims depending therefrom patentably define over the cited combination of Nakano et al. in view of Anderson et al. under 35 U.S.C. §103(a). Reconsideration by the Examiner and withdrawal of this rejection is therefore respectfully requested.

In view of the foregoing claim amendments and remarks, this application is now in condition for allowance. Reconsideration is respectfully requested. The Examiner is requested to telephone the undersigned to discuss any remaining issues in this application to be resolved. Finally, the Examiner is authorized to charge applicant's Deposit Account No. 19-5425 for any additional charges in connection with this Amendment.

Respectfully submitted,

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